

In re: Michael J. Collins et al.
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REMARKS

This is in response to the Official Action mailed July 19, 2005. Applicant notes with appreciation the Examiner's careful review of the pending claims.

Applicants present new claims 13-21 for consideration by the Examiner. Support for the new claims can be found throughout the application as filed, and accordingly the new claims do not introduce new matter. See, for example, paragraphs [0036], [0037] and [0038] of the application as filed electronically. Entry and consideration of new claims 13-21 is accordingly respectfully solicited.

The Examiner argues that the claims are not enabled and are indefinite. In addition, the Examiner has rejected the claims as anticipated, relying on the Roudaout article, the Alanen article, Pourahmady (U.S. Pat. No. 5,292,823). Applicants respectfully traverse the rejections of record and offer the following comments in support of the patentability of the present invention.

Applicants traverse the enablement rejection. The test of enablement is whether one skilled in the art could make or use the invention from the disclosures in the specification coupled with information known in the art without undue experimentation. A patent need not teach, and preferably omits, what is well known in the art.

The absence of working examples does not by itself render an invention non-enabled. Indeed, in the present application, the Examiner acknowledges that the Applicants actually provide examples of the recited pad and sheet materials. Even a single working example in the specification for a claimed invention can be sufficient to obviate an enablement rejection.

Applicants further submit that the specification provides numerous properties of suitable materials useful as the pads and sheet materials of the claimed invention. One of ordinary skill in the art would understand the meaning of these terms and could accordingly readily select materials suitable for use in the invention which exhibit the noted properties.

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In addition, one of ordinary skill in the art could readily evaluate materials to determine if the materials exhibit the recited properties without undue experimentation. Stated differently, evaluations for determining if a material has the recited properties are routine in the chemical arts and thus not unduly burdensome. For example, obtaining NMR spectrum is routine in the chemical arts and would not impose an undue burden on the skilled artisan. The test of enablement is not merely quantitative, and time and difficulty of experiments are not determinative if they are merely routine.

The Applicants accordingly submit that the claimed invention is enabled and respectfully request withdrawal of the enablement rejection.

Applicants also traverse the indefiniteness rejection. Claim 1 recites a sample including "an organic portion containing at least some fats and oils." Applicants submit that the skilled artisan would understand the meaning of this term, particularly in view of the teachings of the specification. Without limiting the scope of protection afforded Applicants, the Examiner's attention is directed to the specification, for example, to paragraph [0002] of the application as filed electronically, which discusses the problems associated with the chemical analysis of foodstuffs and other materials for which it is advantageous to know moisture and fat and oil content. See also paragraphs [0003] and [0051] and the table at paragraph [0056], which gives non-limiting examples of samples for NMR analysis in accordance with the claimed invention.

Also without limiting the scope of protection afforded Applicants, the specification further describes functional properties of the pads and sheet materials of the claimed invention. Functional claim language is proper and does not, in and of itself, render a claim improper. In addition, the specification sets forth exemplary materials useful for the pads and sheets of the claimed invention.

The Applicants submit that the claimed invention is definite, and one of ordinary skill in the art would understand the meaning of the terms objected to by the Examiner. Applicants accordingly respectfully request withdrawal of the indefiniteness rejection.

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The Examiner also argues that Claims 1-2, 5, 8 and 10-12 are anticipated by "any sandwich made of bread, which does not contain dough conditioners (comprising lipids) and any food product comprising fat or oil (butter, meat, fish, etc.) and wrapped in any convention polyvinyl chloride (PVC) wrapper." The Examiner points to Roudaout et al., Alanen et al., and Pourahmady to support her conclusion. Applicants respectfully traverse this rejection as well.

As a preliminary matter, Applicants respectfully note that the prior response did address the Examiner's anticipation rejection based upon the combination of three references as "evidence." Nonetheless, in the present rejection, the Examiner relies upon yet another citation ("Lipids: Fats, Oils, Waxes, etc." of the University of Cincinnati webpage) as additional evidence supporting the anticipation rejection. Applicants respectfully submit, however, that the four different citations are not evidence that the claimed invention lacks novelty.

The Examiner relies upon Roudaout to support the position that bread is a substrate satisfying the recitation of a pad that is "free of atoms that would interfere with or mask the proton NMR response of the protons in the fats and oils in the sample." The Examiner modifies the bread of Roudaout by relying upon yet another citation (the University of Cincinnati webpage) to exclude "dough conditioners."

Roudaout does not teach that the lipids analyzed are "dough conditions." Roudaout points to various contributors to the lipid fractions analyzed, including "intrinsic lipids, i.e., the flour lipids" and milk fat added to the bread. See pages 151 and 152, under the heading "Discussion." Accordingly, even if the bread of Roudaout were modified to exclude dough conditions, which motivation is lacking, the bread is still not "free of atoms that would interfere with or mask the proton NMR response of the protons in the fats and oils in the sample."

Applicants respectfully submit that the references have been applied in hindsight with the Office merely selecting the desired elements from each reference while ignoring

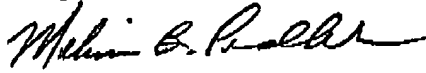
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the overall teaching of the references and similarly ignoring the overall frustration of purpose that the combination would bring. Therefore, Applicants submit that the "sandwich" prior art, either considered alone or in view of the combination of cited references, fails to render the pending claims anticipated or obvious.

The rejections of record having been addressed in full, Applicants submit that the present application is in condition for allowance and respectfully request that the Office pass the claims to allowance at the earliest possible date. Should the Examiner have any questions regarding the foregoing, it is respectfully requested that the Examiner contact the undersigned at her convenience.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 50-0332.

Respectfully submitted,



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